UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANDREAS MESCHENMOSER

Appeal No. 2004-0797
Application No. 09/982,175

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Before considering the appeal on its merits, we find it necessary to remand this application to the examiner under the authority of 37 CFR § 41.50(a)(1).[1]

[1] This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

BACKGROUND

The two rejections under appeal as stated in the examiner's answer are as follows:

1. Claims 1-9 and 12 -41 are rejected under 35 U.S.C. § 103 as being unpatentable over DE '048[2] and/or Schiel et al.[3], further as necessary with MacDonald et al.[4], further in view of Dahl[5] and/or Meinander[6] and Justus et al.[7].

2. Claims 13-17,22, 40 and 41 are rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claims above, and further in view of Laapotti '778[8].

The conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections are set forth in the answer (mailed July 16, 2003), the brief (filed April 21, 2003) and the reply brief (filed September 16, 2003).

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[2] DE 298 11 048 U1. The examiner considers (answer, p. 3) U.S. Patent No. 6,406,596 to be an English language counterpart to this German reference.
[3] U.S. Patent No. 6,065,396.
[4] Pulp and Paper Manufacture, Vol. III, McGraw-Hill Book Co., pp. 583- 590.
[5] U.S. Patent No. 4,915,790.
[6] U.S. Patent No. 4,492,611.
[7] U.S. Patent No. Re. 31,923.
[8] U.S. Patent No. 5,662,778.

DISCUSSION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As the Supreme Court observed in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

> While the ultimate question of patent validity is one of law, . . . the § 103 condition [that is, nonobviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Thus, initially, the scope and content of the prior art are to be determined. In the prior art rejections before us in this appeal (answer, pp. 3-5), the examiner has briefly set forth the teachings of the applied prior art.

Secondly, the differences between the applied prior art (e.g., DE '048 and/or Schiel) and the claims at issue are to be ascertained. This the examiner has not done. Then, the examiner must determine if the ascertained differences between the subject matter sought to be patented and the combined teachings of the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. The examiner has not determined that the actual differences between the subject matter sought to be patented and the combined teachings of the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Since the examiner has not made the above-noted determinations necessary to support a rejection under 35 U.S.C. § 103, the examiner has not yet established a prima facie case of obviousness under 35 U.S.C. § 103.

Additionally, in order to expedite further examination of the claimed subject matter we make the following comments. With regard to the examiner's proposed

combination of DE '048 and/or Schiel in view of Dahl and/or Meinander, it is our view that the combined teachings thereof are not suggestive of replacing the felt belts in DE '048 or Schiel with a water permeable wire web. However, Dahl, for example, may have made it obvious at the time the invention was made to a person of ordinary skill in the art to have added wire storage belts to the press system shown in Figure 5 of DE '048 for the advantages taught by Dahl at column 5, lines 15-24. In any case, this is not the rationale used by the examiner in the rejections under appeal.

On pages 18 to 22 and 25 to 26 of the brief, the appellant provided specific arguments as to why claims 2 to 9, 12 to 18, 20 to 22, 24 to 36 and 38 to 41 were patentable over the applied art. The examiner did not respond to these arguments in the answer.

REMAND

We remand this application to the examiner to further consider if the claimed subject matter is patentable over the prior art of record. In that regard, the examiner must ascertain the specific differences between each of the claims under appeal and DE '048 and Schiel[9] and then determine if the subject matter, as a whole, of each of the

[9] Assuming that either DE '048 or Schiel is considered by the examiner as being the primary reference relied upon in the rejections under appeal.

claims under appeal would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the other prior art relied upon in the rejections under appeal. If the examiner determines that any rejection is to be maintained the examiner must, on the record, specify the differences between each rejected claim and the applied primary reference (e.g., DE '048) and provide detailed reasoning why the differences between the subject matter sought to be patented and the applied primary reference are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

In addition, if any rejection of claims 2 to 9, 12 to 18, 20 to 22, 24 to 36 and 38 to 41 is maintained, the examiner must respond to the appellant's arguments concerning those claims set forth on pages 18 to 22 and 25 to 26 of the brief.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

REMANDED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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